

### **REMARKS**

Claims 1, 2, 7, 9, 14, 15, and 17-19 are pending in this application. Claims 3, 5, 6, 8, 10-13, 16, and 20-24 were previously canceled without prejudice to applicants' right to pursue them in one or more continuation, continuation-in-part, or divisional applications. Claims 1, 2, 7, 9, 14, 15, and 17-19 as amended without prejudice are presented for the Examiner's review and consideration. Claims 1 and 2 have been amended in part and without prejudice for clarification purposes. The term "adopted" in claims 1 and 2 has been deleted and replaced with the term "adapted". These amendments clarify the meaning of claims 1 and 2 without narrowing the scope of the claims by correcting a typographical error in the claim amendments presented in applicant's Amendment filed March 22, 2001. No new matter has been added, as the amendments and new claims are supported by the drawings and specification as originally filed.

### **Claim Rejections- 35 U.S.C. § 102**

#### **U.S. Patent No. 5,702,451 to Biedermann et al.**

Claims 1, 7, 9, 14, 15, and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,702,451 to Biedermann et al. (the "Biedermann '451 patent"). Applicants disagree.

The Biedermann '451 patent does not teach or suggest a first channel extending across at least a portion of the top surface from the perimeter edge. As an initial matter, Applicants disagree with the Examiner's assertion that holes 14 can be construed as "channels" or that prongs 21 "have channels established anterolaterally between the prongs," for the reasons presented in Applicants Amendment submitted on March 22, 2001. Moreover, the Biedermann '451 patent does not teach, suggest, or disclose that holes 14 or prongs 21 have spaces therebetween which are for receiving a surgical instrument. However, assuming for the sake of argument that either of these elements can be construed as "channels", they do not extend across at least a portion of the top surface from the perimeter edge, as recited in claim 1. In contrast, the holes 14 of the Biederman '451 patent are located on the interior of the plate, spaced from the perimeter edge, and extend longitudinally through the plate. The spaces between prongs 21 are not on the top surface whatsoever. Additionally, the prongs 21 are inserted into recesses 9, 10, 9', 10' of jacket 1 so that any space between the prongs is contained within the jacket and cannot be used to receive a surgical instrument.

As the features recited in claim 1 are not taught or suggested by the Biedermann '451 patent, Applicants submit that this claim is allowable over the cited reference. With respect to claims 7, 9, 14, 15, and 17, which depend from claim 1, Applicants submit that, because these claims define more particular aspects of Applicants' invention (as well as including the features of claim 1), they are also patentably distinguished over the Biedermann '451 patent for the above reasons, as well as the totality of the claimed invention.

U.S. Patent No. 5,776,197 to Rabbe et al.

Claims 1, 2, 9, and 14 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,776,197 to Rabbe et al. (the "Rabbe '197 patent"). For the reasons which follow, Applicants submit that the Rabbe '197 patent does not teach or suggest the invention as now claimed.

First, the Rabbe '197 patent does not teach or suggest an end member with a second portion configured and dimensioned to be inserted into a bore of the implant. In contrast, the second portion of the Rabbe '197 patent identified by the Examiner has an annular surface with internal threading that goes outside of the threaded cylindrical body 21. (See Fig. 3). In addition, it is clear that element 35, which the Examiner alleges to be a shoulder, is not sized to rest on an end edge of the implant, as this element never contacts body 21. In fact, since the second portion of the Rabbe '197 patent goes outside of body 21, the alleged shoulder must necessarily be sized larger than body 21, not sized to rest on an end edge thereof. Thus, the Rabbe '197 patent teaches away from the claimed invention.

As the features recited in claim 1 and 2 are not taught or suggested by the Rabbe '197 patent, Applicants submit that these claims are allowable over the cited reference. With respect to claims 9, and 14, which depend from claim 1, Applicants submit that, because these claims define more particular aspects of Applicants' invention (as well as including the features of claim 1), they are also patentably distinguished over the Rabbe '197 patent for the above reasons, as well as the totality of the claimed invention.

In addition, with respect to claim 2, claim 2 recites that the teeth are provided in a two dimensional array with the teeth being spaced apart from one another for interlocking with the bone. As the teeth of the Rabbe '197 patent form a single ring and not a two dimensional array, Applicants submit that claim 2 is patentable over this reference for this additional reason.

**Claim Rejections- 35 U.S.C. § 103**

Claims 1, 2, 17, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,700,291 to Kuslich et al. (the “Kuslich ‘291 patent”) in view of U.S. Patent No. 6,143,033 to Paul et al. (the “Paul ‘033 patent”).

First, with respect to the Paul ‘033 patent, pursuant to 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l)(1), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Common ownership of the Paul ‘033 patent and the rights to the present application may be found in the assignment documents which are recorded in the Patent and Trademark Office at Reel 9818, Frame 0557 for the Paul ‘033 patent and at Reel 010597, Frame 0246 for the present application, conveying the entire rights in the applications to “Synthes (U.S.A.)” of Paoli, PA, the same organization. Accordingly, the Paul ‘033 patent is disqualified as prior art against the presently claimed invention.

As noted by the examiner, the Kuslich ‘291 patent alone does not teach or suggest the invention as claimed. Thus, Applicants respectfully submit that claims 1, 2, 17, and 18 are patentable over the Kuslich ‘291 and Paul ‘033 patents.

**Conclusion**

In view of the foregoing amendments and remarks, it is believed that all rejections have been overcome and should be withdrawn. Thus, all current claims are submitted to be in condition for allowance, early notice of which would be appreciated. The Examiner is invited to call the undersigned at (202) 469-4553, if a telephone call could help resolve any remaining items.

Applicants believe that no fees are due in connection with the submission of this amendment. Should any other fees be required, please charge all required fees under 37 C.F.R. 1.17 to Pennie & Edmonds Deposit Account No. 16-1150.

Respectfully submitted,

Date November 25, 2003

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Attachment

"ATTACHMENT A"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: MESSERLI *et al.*

Application No.: 09/497,123

Filed: February 3, 2000

For: END MEMBER FOR A BONE FUSION  
IMPLANT

Confirmation No.:

Group Art Unit: 3738

Examiner: Brian E. Pellegrino

Attorney Docket No.: 8932-114



**COMMUNICATION CONCERNING  
FILING OF REQUEST FOR CONTINUED EXAMINATION**

Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

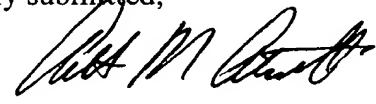
RECEIVED  
DEC 02 2003  
TECHNOLOGY CENTER R3700

In response to the Decision on Appeal mailed September 26, 2003, a Request for continued examination (RCE) under 37 § 1.114 is being filed with the Examiner, concurrently with this communication. A courtesy copy of the request for continued examination and the first page of the amendment filed therewith is provided as "Attachment A". Applicants respectfully inform the Board of the filing of the timely Request for continued examination to avoid any inadvertent termination of proceedings in this application.

No fee is believed due for this submission, however, should any fees be required, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

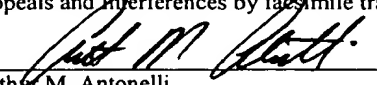
Respectfully submitted,

Date November 25, 2003

  
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CERTIFICATION OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. 1.8(a)

I hereby certify that this paper is being filed with the United States Patent and Trademark Office Before the Board of Patent Appeals and Interferences by facsimile transmission on November 25, 2003 to facsimile telephone number (703) 308-6199.

 11/25/2003 51,410  
Arthur M. Antonelli (Reg. No.)